

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. CLINTON

Appeal No. 98-1419
Application 08/437,543¹

ON BRIEF

Before CALVERT, ABRAMS and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 20, all the claims in the application.

¹ Application for patent filed May 9, 1995.

Appeal No. 98-1419
Application 08/437,543

The subject matter on appeal concerns a ladder assembly, a method relating thereto, and a railroad crossing and ladder assembly. The appealed claims are reproduced in the appendix of appellant's brief.

The prior art applied in the final rejection is:

Anderson	19,659	Jan. 25, 1890
(British Patent)		

The admitted prior art in appellant's application, i.e., Figures 1 and 2, page 1, lines 6 to 15, and page 5, line 26 to page 6, line 12 (APA).

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 1 to 14 and 18 to 20, for failure to comply with 35 U.S.C. § 112, second paragraph;
- (2) Claims 1 to 20, unpatentable over APA in view of Anderson, under 35 U.S.C. § 103.

Rejection (1)

The test for compliance with the second paragraph of 35 U.S.C. § 112, as stated in Miles Laboratories, Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), is:

whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.

See also In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975):

The question under § 112, second paragraph, is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes

the subject matter with sufficient precision that the bounds of the claimed subject matter

are distinct.

In the present case, the examiner considers independent claim 1 to be indefinite in that the "means for retaining" recited in the last paragraph of the claim

certainly is not the disclosed means (bracket 50) as clearly evidenced by Figures 4-5. Further, how is it that the ladder assembly can have mounting means to move the bottom end toward and away from the first ladder (lines 13-16) while simultaneously having retaining means to keep the bottom end horizontally adjacent the ladder? These two limitations appear to be contradictory of one another. (Answer, pages 4 and 5).

We do not consider the examiner's position to be well taken. Appellant clearly discloses on page 2, line 25 to page 3, line 3, and page 8, line 24, to page 9, line 28, what the retaining means comprises. Reading claim 1 in light of this disclosure, as Miles Laboratories and In re Merat, *supra*, indicate that it must be, one of ordinary skill would readily understand the scope of the "means for retaining" language recited therein.

The examiner further considers independent claim 18 to lack compliance with § 112, second paragraph, because (answer, page 5, original emphasis):

the claim is incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. MPEP § 2173.05(1)². Specifically, on line 9, it is unclear to what said second ladder is mounted to, and thus there is no structural cooperative relationship between the first and second ladders. Note that the Applicant has set forth that the second ladder is "mounted for sliding movement with respect to said first ladder, and for pivotal movement with respect to said first ladder", but has not specifically set forth to what said second ladder is mounted, and thus has omitted the essential structural

² This section has been deleted from the current (July 1998) edition of the MPEP.

cooperative relationship between said second ladder and the other positively set forth elements of the claim. Further, note that sliding and pivotal movement of one element with respect to another element in a claim does not positively set forth nor necessarily infer that said one element is structurally attached to said another element.

We do not agree with the examiner, because in our view claim 18 satisfies the test for compliance with § 112, second paragraph, set forth in Miles Laboratories and In re Merat, *supra*. Reading this claim in light of the disclosure, we consider that the bounds of the claim would be understood by one of ordinary skill in the art. The fact that the claim does not specify where or on what the second ladder is mounted does not render the claim indefinite, but simply means that the claim is broad enough to read on any mounting which will permit the second ladder to slide and pivot in the manner recited.³ As appellant states on page 6 of his brief, "[m]ere breath does not equate to indefiniteness (see In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 599-600 (CCPA 1971))."

Rejection (1) will therefore not be sustained.

Rejection (2)

We are at somewhat of a loss to understand the basis of this rejection. The examiner states on page 6 of the answer that element(s) A of Anderson are "a first ladder", which they clearly are not, and then states on page 13 that he has relied on the teaching of ladder B "which is pivotally and slidably

³ We note that since claim 18 has not been rejected under the written description requirement of § 112, first paragraph, the examiner evidently does not consider it to be broader than the supporting disclosure. Cf. Gentry Gallery Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998).

mounted to a vertical ladder-like structure". Presumably the "examiner is referring to Anderson's elements A as "a vertical ladder-like structure," but elements A are merely a pair of stanchions which extend between the beam or hatch coaming and the keelson of a vessel, and have no rungs or other structure extending between them which would cause them to be "ladder-like". Moreover, as appellant points out (brief, page 8), the space between stanchions A must be open in order to store ladder B between them (Anderson discloses at page 1, lines 27 and 28, that "[w]hen not required for use, the ladder is placed between the pillars or stanchions A").

Since there is no suggestion or teaching in the applied prior art of a second ladder which is movable relative to a first ladder in the manner claimed, we will not sustain rejection (2).

Conclusion

Appeal No. 98-1419
Application 08/437,543

The examiner's decision to reject claims 1 to 20 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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Appeal No. 98-1419
Application 08/437,543

NIXON and VANDERHYE
8TH FLR.
1100 NORTH GLEBE ROAD
ARLINGTON, VA 22201-4714